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Leo J. Campbell

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EXAMINER

BRUCKART, BENJAMIN R

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/809,581	Applicant(s) CAMPBELL ET AL.	
	Examiner BENJAMIN R. BRUCKART	Art Unit 2478	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-22, 50-54, 69, 76, 79, 86 and 92-94 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-22, 50-54, 69, 76, 79 and 86, 92-94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Detailed Action

Status of claims:

Claims 18-22, 50-54, 69, 76, 79 and 86, 92-94 are pending in this Office Action.

No claims are amended.

Claims 1-17, 23-49, 55-68, 70-75, 77-78, 80-85, 87-91 remain cancelled.

Response to Arguments

Applicant's arguments filed 8/27/10 have been fully considered but are found not persuasive. The declarations filed on 8/27/10 under CFR 1.131 have been reviewed by the examiner.

The declarations filed 8/27/10 under 37 CFR 1.131 has been considered but is ineffective to overcome the King reference.

It appears that Applicant intends to show invention of the claimed subject matter prior to the March 9th, 2000 date established by King by showing conception of the invention prior to 3-9-00 to the filing date of the present application 3-17-2000.

I. Conception

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the King reference (3-9-2000). While conception is the mental part of the inventive act; it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must be comprehended. See *Mergenthaler v Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

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The affidavit or declaration and exhibits must clearly explain which facts or data Applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what exhibits describe along with a general assertion that the exhibits describe a reduction to practice “amounts to essentially a mere pleading, unsupported by proof or a showing of facts”, and, thus, does not satisfy the requirements of 37 CFR 1.131(b). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied upon by applicant. *See* MPEP § 715.07(I).

With regard to the submissions, the declarations of Ray, Campbell, Orbke fails to clearly explain which facts or data are being relied upon to show conception of the invention prior to the critical date. The declaration relies on Attachments/Exhibits A and B but this evidence is absent. Therefore no exhibits or evidence and makes no reference to the features of the independent claims, such as a "receiving the message directed to the user with the electronic account, where the message includes an electronic address associated with the user's electronic account and a non-standardized physical address of the user; and determining a standardized physical address of the user from the electronic address using an address database; and linking the standardized physical address to the electronic account; determining a preferred address of the user, the preferred address being one of the electronic address and the standardized physical address linked to the electronic account; and delivering the message to the user at the preferred address".

There is no document showing evidence of conception of such a feature, the declaration has failed to clearly explain how and/or where it does so. Therefore, the evidence is insufficient to show evidence of conception.”

Only part of the inventorship has declared in the received 37 CFR 1.131 on 8/27/10, raising to question the true inventorship and inventive entity prior to 3-9-2000.

II. Diligence

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In determining the sufficiency of a 37 CFR 1.131 declaration/affidavit, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. (See MPEP 715.07(a)). However, in the interest of expedited prosecution, the Examiner provides the following observations regarding the evidence of diligence.

No Exhibits describe acts occurring during the critical period. There are no accompanying details specific enough to account for the entire critical period. It appears that Applicant intends to account for this entire time period by asserting that an application was being prepared.

For Prior to the “application disclosure”, nearly 8 days are unaccounted for, including March 9-17th, the beginning of the critical period. While a time period as short as two days is not necessarily unacceptable, a 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983). Additionally, if work on the application did not begin until after the critical date, the entire time period cannot be accounted for with attorney diligence, regardless of specificity.

Also of concern is the time period between March 9th and March 17th, 2000, a period of eight days. During this time period, no details or evidence accounts for time worked on the application. No evidence, exhibits are submitted although Exhibits A and B are submitted referred to in the declarations.

Applicant's invention as claimed:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 18-22, 50-54, 69, 76, 79 and 86, 92-94 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7, 33-49, 65-68 and 72-75 of copending Application No. 12155912. Although the conflicting claims are

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not identical, they are not patentably distinct from each other because they are both similar for linking accounts to addresses

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 18-22, 50-54, 69, 76, 79 and 86, 92-94 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-16, 54-59, 89-90, 96-97, 101-104 of copending Application No. 09809326. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both similar for linking accounts to addresses

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 18-22, 50-54, 69, 76, 79 and 86, 92-94 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 12, 19-47, 75-103, 116-118, 123-125 of copending Application No. 11179546. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both similar for linking accounts to addresses

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Claims 18-22, 50-54, 69, 76, 79 and 86, 92-94 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6-10, 49-53, 88, 95, 101-108 of copending Application No. 12071705. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both similar for linking accounts to addresses

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 93-94 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 93 recites the limitation "vanity" email address. Applicant has provided evidence that vanity is an obvious feature in the art. The indefinite issue circles how a vanity email address is different than an email address. It is unclear and indefinite.

Claim 94 does not narrow claim 93. Claim 93 states the alternate electronic address is an email but claim 94 conflicts with claim 93 and says the email address which is an alternate electronic address is also a telephone number. This is inconsistent and does not properly narrow claim 93, instead it conflicts with it.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 18-20, 22; 50-52, 54; 69; 76; 79; 86 are rejected under 35 U.S.C. 103(a) as being unpatentable by U.S. Patent Publication No. 2002/0002590 by King et al

Regarding claim 18, the King reference teaches a method for delivering a message to a user with an electronic account (King: pages 1-2, para 18-20; provisional page 1, para 1-2), comprising the steps of:

receiving the message directed to the user with the electronic account (King: pages 1-2, para 18-20; provisional page 1, para 2-3), where the message includes an electronic address associated with the user's electronic account and a non-standardized physical address of the user (King: page 2; para 22-23); and

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determining a standardized physical address of the user from the electronic address using an address database (King: page 2, para 22-23); and

linking the standardized physical address to the electronic account (King: page 2, para 21 “the email would still be routed based on the recipient’s physical address” and para 30; the electronic account that associated email with the account number, ‘his physical address’; provisional page 1);

determining a preferred address of the user, the preferred address being one of the electronic address and the standardized physical address linked to the electronic account (King: Fig. 2, page 1-2, para 18-20; electronic inbox on email server or hard mail; page 3, para 33-34 designates how data is received; provisional page 1, para 2; opt in address); and

delivering the message to the user at the preferred address (King: page 2, para 22-23, 30; provisional).

Regarding claim 19, the method of claim 18, wherein the preferred address is the electronic address (King: page 2, para 30).

Regarding claim 20, the method of claim 18, wherein the preferred address is the standardized physical address (King: page 2-3, para 31-32).

Regarding claim 22, the method of claim 18, wherein the address database is a United States Postal Service address database (King: page 2, para 22).

Claims 50-52, 54; 69, 76, 79, 86 are rejected for the same rationale as given above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21, 53 are rejected under 35 U.S.C. 103(a) as being unpatentable by U.S. Patent Publication No. 2002/0002590 by King et al in view of U.S. Patent No. 5,341,505 by Whitehouse.

Regarding claim 21, the King reference teaches a method for delivering a message to a user with an electronic account.

The King reference does not explicitly state sending back information of a standardized physical address.

However the Whitehouse reference teaches sending back information of a complete physical address (Whitehouse: col. 6, lines 52-58) in order to providing quick, easy, and low cost lookup for complete address information (Whitehouse: col. 5, lines 57- col. 6, line 5).

It would have been obvious at the time of the invention to one of ordinary skill in the art to create the system of delivering a message as taught by King to include informing the sender of a complete address as taught by Whitehouse in order to remove the last barrier for automation providing quick, easy, and low cost lookup for complete address information (Whitehouse: col. 5, lines 57- col. 6, line 5).

Claims 53 are rejected at the same rationale as above.

Claims 92-94 rejected under 35 U.S.C. 103(a) as being unpatentable by U.S. Patent Publication No. 2002/0002590 by King et al in view of U.S. Patent Publication No. 2001/0020242 by Gupta et al.

Regarding claim 92, the King reference teaches the method of claim 18.

The King reference fails to teach an alternative email address.

However, the Gupta reference teaches linking an alternate electronic address to the electronic account (Gupta: page 5, para 58-59); and

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the preferred address may also be determined to be the alternative electronic address linked to the electronic account (Gupta: page 5, para 58-59) in order to delivery content to the user (direct mails or mass emailing; page 5, para 58; page 6, para 77).

It would have been obvious to one of ordinary skill in the art at the time of the invention to create the invention of King to include alternative contact info as shown in Gupta in order to allow other ways to provide content to a user (direct mails or mass emailing; page 5, para 58; page 6, para 77).

Regarding claim 93, the method in claim 92, wherein: the alternate electronic address is a vanity email address (Gupta: page 5, para 58 “alternate email address”).

Regarding claim 94, the method in claim 93 wherein: the alternate electronic address is a telephone number (Gupta: page 5, para 58, “phone number”).

REMARKS

Applicant's affidavit accompanies arguments that the claims are allowable for the reasons related to the declaration under 37 CFR 1.131.

The examiner maintains that when the affidavit is perfected, additional prior art can be cited to support the rejection.

The examiner re-iterates and encourages detailing the features of the mailing lists associated with street addresses (page 16 of specification), verifying ID through official clerks (spec page 17) and other detailed features from the specification are necessary to approach allowability.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN R. BRUCKART whose telephone number is (571)272-3982. The examiner can normally be reached on 8:30-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey C. Pwu can be reached on (571) 272-6798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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